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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,604	05/15/2001	Volker Benz	208437US0 DIV	9548

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary

Application No.

09/854,604

Applicant(s)

BENZ ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 12,13 and 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the response mailed July 11, 2003. The finality of the office action mailed April 9, 2003 has been withdrawn and the amendment filed June 2, 2003 has now been entered rendering claims 9-21 pending.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Inamura et al. (U.S. 5,342, 189).

4. Inamura discloses an extrusion die slit with an entry-side and exit region (column 5, lines 10-23) where the entry opening of the die is the port area (column 8, lines 30-33). Figure 2 depicts parallel exit slits and a plurality of exit ports.

Claim Rejections – 35 USC § 102(b)

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Ramanathan et al (U.S. 5,269,995).

6. Ramanathan discloses a composite formed of alternating layers of differing thermoplastic material parallel to one another which are passed through an extrusion die (column 3, line 48 through column 4, line 22). 'The extrusion die...adapted for producing a multilayer plastic composite by a method' and '...said method comprising coextruded plastic A and plastic B through said die, wherein said coextruding plastic A and plastic B comprises forming a pair of fluid streams of plastic A by passing a fluid stream of plastic A through said pair of parallel exit slits and forming a plurality of fluid streams of plastic B with gaps between each stream of said plastic B by passing a fluid stream of plastic B through said plurality of exit ports, so that said fluid streams of said plastic A exit said pair of exit slits and said fluid streams of plastic B exit said plurality of exit ports in such a manner to result in a portion of said fluid streams of said plastic A passing through said gaps between each stream of said plastic B to effect fusion of said pair of fluid streams of said plastic A, to obtain said composite' are product by process claim limitations. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

Claim Rejections – 35 USC § 103(a)

Art Unit: 1774

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inamura et al. (U.S. 5,342, 189) in view of Ramanathan et al (U.S. 5,269,995).

Inamura discloses an extrusion die slit with an entry-side and exit region (column 5, lines 10-23) where the entry opening of the die is the port area (column 8, lines 30-33). Figure 2 depicts parallel exit slits and a plurality of exit ports. Inamura does not disclose a sequence of alternating layers of different thermoplastic material. Ramanathan discloses a composite formed of alternating layers of differing thermoplastic material parallel to one another which are passed through an extrusion die (column 3, line 48 through column 4, line 22). Inamura and Ramanathan are analogous art because they are both from the field of multi-component articles. It would have been obvious to one of ordinary skill in the art to include alternating layers in the extrusion die of Inamura because Ramanathan teaches the multilayer body helps protect the article from instability during formation (abstract). In instant claim 11, '...adapted for producing a multilayer plastic composite' and '...to form gaps in said layer of plastic B, and said gaps in said layer of B are filled with plastic A' are product by process claim limitations. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

Art Unit: 1774

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Inamura does not show that the extrusion die has the same thicknesses as in instant claims 14-17. However, such thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness(es), absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the mechanical strength and stability of the extrusion die. As such, they are optimizable. It would have been obvious to one of ordinary skill in the art to make the extrusion die with the limitations of the thicknesses since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

9. Claims 12-13 and 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Rejection of claim 9 made under 35 U.S.C. 102(b) as being anticipated by Inamura et al. (U.S. 5,342, 189) has been maintained because Applicant failed to address why the instant application is not anticipated by the reference. Additionally, Rejection of claim 10 made under 35 U.S.C. 102(b) as being anticipated by Ramanathan et al (U.S. 5,269,995) has been maintained because Applicant failed to address why the instant application is not anticipated by the reference.

11. Applicant's amendment after final necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

